

updating said displayed total price value in accordance with changes in said selected features separate from the operation of said network addressable site;
returning information via said network to said network addressable site having data representing at least said features selected when the user of each of said computer systems has completed the configuration of the product; and
determining at least one of new product, product configuration, pricing, or segmentation in accordance with said information.

Applicants submit that the returned information having data representing at least features selected when the user of each computer system has completed the configuration of the product is a tangible “real-world” result of the claimed invention. Such returned information clearly has practical application in the technological arts of market research, such as conducted over a computer network, for e.g., the Internet. It is the Examiner’s position that the determining step provides no real world result, however, under MPEP 2106 “only one [practical application] is necessary”.

Moreover, if transformation of data by a machine into a final share price constituted a useful, concrete, tangible result in State Street Bank & Trust Co. v. Signature Financial Group, 149 F.3d at 1373, 1368, 47 USPQ2d 1601, 1596 (Fed. Cir. 1998), then the market research software, which allows the user of that computer system to select the features of a product configuration, and updates a displayed total price value of the product at the computer system in accordance with price values of the selected features, such that data representing at least the features selected is produced, must also be sufficiently transformative to constitute a useful, concrete, tangible result. Further, such late rejecting of the claims under 35 U.S.C. 101 is not well taken as these same claims were already examined by the U.S. Patent Office by the previous Examiner who did not reject them under 35 U.S.C. 101. Accordingly, withdrawal of the 35 U.S.C. 101 rejection is respectfully requested.

Claims 25-29, 40, and 42-46 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,477,504 (Hamlin et al.) “Hamlin” in view of Susan Schwarz McDonald Paper entitled “How to Design and Implement Successful Pricing Research”, October 1995 (McDonald).

Hamlin describes at column 11, lines 21-24, that its survey “consists of one or more HTML pages that are accessible over the Internet or Intranets to network users wanting to take the survey”, where a survey is questions and responses (see e.g., FIG. 4, and column 7, lines 18, to column 9, line 18). Further, Hamlin describes that “[w]hen a network user completes a

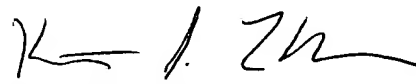
survey, the results are automatically sent over the network system where they are validated and stored in a corresponding storage unit (e.g. database)” see column 13, lines 45-48. Thus, Hamlin fails to describe or suggest sending market research software to any computer to select the features of a product configuration, displaying via the market research software a total price value in accordance with price values of the selected features, updating the displayed total price value in accordance with changes in the selected features, or returning information via a network to a network addressable site having data with at least such selected features. Merely conducting question/answer surveys of Hamlin cannot describe each and every step of Claim 25, and especially does not suggest any market research software which enables the claimed method’s displaying, updating, or returning steps.

Market research firms have conducted product configuration research to determine better ways to market or package product/services, such as using conjoint analysis, to assess different configurations and their pricing. However, prior to the present invention one problem was that it was difficult to conduct on a large scale to obtain desired data for analysis. The present invention solved this problem by its new product configuration software which can be downloaded and operated by a user at his/her computer such that configured product data is returned for analysis. Before the advent of the claimed invention this was a laborious and often expensive process. The McDonald academic article description of the conjoint analysis approach to market research does not solve this problem, but merely highlight the benefits of such analysis in conducting market research, which is insufficient to describe or suggest the market research software absent in Hamlin that is sent over a network to one or more computers to carry out the claimed method’s displaying, updating, or returning steps. It is respectfully submitted that the Examiner is using impermissible hindsight reasoning based on Applicants’ disclosure, and that mere descriptions in the McDonald article associated with conjoint analysis is insufficient to teach or suggest each and every feature of claimed invention, especially where Hamlin is limited to typical question/answer surveys as described above. See MPEP 2143 which states that “[t]he teaching or suggestion to make the claimed invention combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.” citing In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); see also In re Dow Chemical Co., 5 USPQ2d 1529, 1532 (Fed. Cir. 1988), In re Nomiya et al., 184 USPQ 607, 613 (CCPA 1975). For example, it is a feature of Claim 25 that the processes of such market research software for displaying and updating occur separate from the operation of any network addressable site. It is submitted that even if Hamlin and McDonald were combined, there is

clearly no suggestion of this claimed feature, rather the Examiner is clearly using impermissible hindsight knowledge learned from the present application (see MPEP 2143.03). Thus, Claim 25 is not obvious in view of the combination of Hamlin and McDonald. For similar reasons to those argued above, Claim 42 is also not obvious in view of the combination of Hamlin and McDonald. Withdrawal of the 35 U.S.C. 103(a) rejection of Claims 25 and 42 and their respective dependent claims is thus requested.

The absence of claimed features in the combination of Hamlin and McDonald is also clearly evident in many of the dependent Claims. For example, neither Hamlin, nor McDonald describe the Claims 27 and 44 steps of measuring elapse time for each user of the computer systems to configure the product. Neither Hamlin, nor McDonald describe the Claims 28 and 45 data representing the selected features and any changes in the selection of features by the user of each computer system until the product configuration is completed. Neither Hamlin, nor McDonald describe the Claims 40 and 46 step of sending a survey having questions to one of before, after, or before and after the step of sending market research software. Further, given the absence of any discussion of these features in the 35 U.S.C. 103(a) rejection of Claims 27, 28, 40, 44, 45 or 46 in the Office Action of August 8, 2006, a *prima facie* case of obviousness has not been established with respect to such claims (see MPEP 2142-2143), and Applicants respectfully request that such claims be deemed as having allowable subject matter.

Respectfully submitted,



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Dated: November 8 2006

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